REMARKS

Applicant respectfully requests reconsideration of the application.

In the Final Action dated May 5, 2004, claim 2 is objected to as requiring a term or phrase like "comprising" that separates the heading and body of the claims. Claim 2 has been amended to include "the system comprising:" to confirm that the system includes the elements listed in the body of the claim. Previously, the claim recited a system "which includes" various elements.

Claims 5-9 and 15-16 stand rejected as failing to comply with the written description requirement. Applicant draws the Examiner's attention to page 6, lines 5-6 of the specification, which states: "Both the e-mail message itself and any attached documents are passed through the watermark reading program." Combined with the rest of the disclosure, including the portion that defines a document as either "e-mail message, or alternatively...a document that is attached to an e-mail message," the specification clearly describes how documents in and attached to the messages are processed in the manner recited in the claims as previously presented.

Nevertheless, to expand the scope the claim, Applicant has recast the.claim language of claims 5 and 15-16 such that it refers to documents in and attached to the messages being passed to a watermark detecting process. This new claim language is clearly described at page 6, lines 5-6, in the context of the specification.

Claims 1 and 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,958,005 to Thorne et al. ("Thorne") in view of U.S. Patent No. 5,862,260 to Rhoads.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thorne in view of Rhoads, and further in view of U.S. Patent No. 6,615,348 to Gibbs.

Claims 7-13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thorne in view of Rhoads, and further in view of EP 0375138 to Kasiraj et al ("Kasiraj").

Claims 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thorne in view of Rhoads and Kasiraj, and further in view of Gibbs.

Claim 1

As amended, claim 1 recites: "the program operable to read watermarks in documents that form at least part of the messages and operable to read watermarks in documents attached to

the messages." The combination of Rhoads and Thorne fail to teach this aspect of claim 1. Using the "bodier" approach in Rhoads in conjunction with the email header approach in Thorne does not address reading watermarks in both documents that form at least part of message and reading watermarks in documents attached to the messages as claimed.

Claim 2

Regarding claim 2, the combination of Thorne, Rhoads and Gibbs fails to disclose or suggest: "watermark detecting means for detecting and reading watermarks in e-mail messages at the server after the messages are sent from the user but before such messages are transmitted from said e-mail server to the Internet." Previously, the Office rejected claim 2 on two separate grounds: 1. Claim 2 was allegedly anticipated by Gibbs, and 2. Claim 2 was allegedly obvious in view of Rhoads and Thorne. Now, the Office has rejected claim 2 as obvious in view of a combination of Thorne, Rhoads and Gibbs. In this combination, Gibbs is specifically cited as disclosing "an authenticated message server 112 in fig 1 that reads information contained in e-mails to control distribution of the e-mails before the e-mails are transmitted to the Internet" as allegedly explained in column 6, lines 28-37. However, the authentication message server 112 is used to authenticate inbound messages from the Internet as described at column 5, lines 46-47, not before messages are transmitted from an e-mail server to the Internet as claimed. Moreover, Gibbs authentication message server is used to authenticate a received email message. In contrast, claim 2 is concerned with blocking confidential email transmission. Therefore, the combination fails to render claim 2 obvious, and there is no motivation to combine these references.

Claim 3

In regard to claim 3, Rhoads and Thorne fail to teach: "the program operable to read watermarks in documents that form at least part of the messages and operable to read watermarks in documents attached to the messages" as claimed.

Claim 4

Claim 4 is patentable for the same reasons as claim 3.

Claim 5

In regard to claim 5, Rhoads and Thorne fail to teach: "passing messages to a watermark detecting process prior to transmission of said messages including passing documents in and attached to the messages to the watermark detecting process for detecting watermarks in the documents".

Claim 6

Claim 6 is patentable for the same reasons as claim 5.

Claim 7

In rejecting claim 7, the Office acknowledges that Thorne and Rhoads do not teach interrogating a database to determine an action to take based at least in part on the data carried by a watermark. However, the Office contends that Kasiraj teaches comparing a message profile with a previously established profile, "inherently contained in a database."

Kasiraj analyzes restrictions upon receipt of an electronic message as shown in Fig. 3 because the recipient's profile, retrieved from the recipient's system in block 42, is required for the analysis. In contrast, the claim describes an approach for controlling distribution prior to transmission. The combined teachings of Kasiraj, Thorne and Rhoads fail to teach interrogation of a database based on data carried in a watermark as recited in claim 7, and the required motivation to combine these references is lacking.

Claim 8

The combined teachings of Kasiraj, Thorne and Rhoads fail to teach the elements of claim 8, and there is no motivation to combine these references because the recipient's profile is analyzed upon receipt of a message in contrast to the claim.

Claim 9

The combined teachings of the cited art fail to teach all of the elements of claim 9 because they fail to teach an action dependent on information carried by the watermark and information stored in a database as claimed. The motivation to combine these references is lacking as well.

Claim 10

Similarly for claim 10, the combined teachings of the cited art fail to teach all of the elements of claim 10 because they fail to teach how to interrogate a database to determine an action based on information carried by the watermark and information stored in a database as claimed. The motivation to combine these references is lacking as well.

Claims 11-16

Claims 11-16 are patentable for the same reasons as their corresponding independent claims. Additionally, they have other elements that further distinguish them from the cited art. For example, claims 15 and 16 recite: "documents in and attached to the messages are passed to a watermark detecting process for detecting watermarks in the documents in and attached to the messages." The cited art fails to teach this aspect of certain of the claims.

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